

REMARKS

The Examiner is thanked for a telephone interview held on February 25, 2004 between the Examiner, and Dennis Smid and Damon Treitler (two of Applicants' undersigned attorneys).

Amended claim 1 and claims 21-29 are in this application.

Applicants submit that claim 1 has been amended as suggested by the Examiner to overcome the 112 rejection of claims 1 and 21-29.

Claims 1 and 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skarda et al (U.S. Patent No. 5,463,261).

Amended independent claim 1 includes features discussed during the above-mentioned interview, and now recites in part:

"an active antenna device...for receiving broadcast signals having a frequency associated therewith, said antenna device including a converter circuit for converting the frequency of the received signals;

...

wherein when said broadcasting receiver is in said standby state and said detecting means does not detect insertion of said storage medium, said control means stops power supply to the active antenna device."

(Emphasis added).

It is respectfully submitted that Skarda as applied does not specifically disclose the above features of claim 1. More specifically, even though Skarda briefly refers to a "GPS card...suitable for connection to a satellite antenna," Skarda does not indicate 1) whether such antenna is an active or passive type antenna, and 2) that "when said broadcasting receiver is in said standby state and said detecting means does not detect insertion of said storage medium, said control means stops power supply to the active antenna device."

The Examiner concedes that Skarda fails to disclose whether such antenna is an active or passive type antenna. In an attempt to cure such deficiency, however, the Examiner takes Official Notice, and apparently asserts that such antenna would be an active type antenna. The Examiner also appears to take Official Notice with regards to the other above features of claim 1.

In regard to such Official Notice, reference is made to In re Prado and Landau, (214 USPQ 673) in which the Court states at page 677:

Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the

pertinent art and the applicant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.

In view of In re Prado and Landau, it is believed to be improper for the Examiner to fail to cite a reference or references which specifically describes the above features of claim 1.

Furthermore, even if Skarda's GPS card had an active antenna, Skarda nowhere discloses that "when said broadcasting receiver is in said standby state and said detecting means does not detect insertion of said storage medium, said control means stops power supply to the active antenna device," as in claim 1.

Furthermore, it is also respectfully submitted that there is no suggestion in Skarda to modify its power conversion device in the manner apparently proposed by the Examiner. In this regard, reference is made to In re Fritch, (23 USPQ 2d 1780-CAFC 1992) in which the Court states at page 1783:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so'. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification....It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious.** This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". (Underlining and bold added for emphasis.)

There does not appear to be any suggestion in Skarda, as required by the Court in In Re Fritch, to modify their teachings in the manner suggested by the Examiner. Accordingly, Applicants submit that claim 1, and claims 21-29 dependent therefrom, are distinguishable from Skarda.

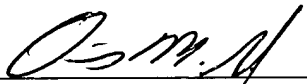
It is respectfully submitted that all of the claims in the present application are in condition for allowance. An early notice to this effect is respectfully solicited.

Statements appearing above in regard to the cited reference represent the opinions of Applicants' undersigned attorney and, if the Examiner disagrees with any of such opinions, it is

respectfully requested that the Examiner indicates specifically where in the reference there is a basis for a contrary view.

Please charge our Deposit Account No. 50-0320 for any additional fees that may be necessary in connection with the filing of this amendment.

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